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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,722	04/28/2000	RONALD G PARKINEN	K35A0604	5247

35219 7590 09/18/2006

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EXAMINER

NGUYEN, HUY THANH

ART UNIT PAPER NUMBER

2621

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,722

Applicant(s)

PARKINEN ET AL.

Examiner

HUY T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 22, 26-27, 29-31, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Goldwasser et al (US 5,241,428).

Regarding claim 22, Sato et al, as discussed in the last Office Action, discloses a video recording system to record an external video data for a video program segment selected using an electronic program guide (Fig. 2), the video recording system comprising:

a user interface (the remote controller disclosed in col. 4, lines 46-48 and in col. 5, lines 48-50) that receives user input;

a video input interface (tuner 37 of Fig. 2, col. 3, lines 59-65) that receives the external video data for the selected video program segment;

an isochronous interface (IEEE1394 disclosed in col. 6, lines 57-60 and video disk disclosed in col. 7, lines 19-26) connectable to an external hard disc drive; and

a video data management system that:

uses the electronic program guide to select the video program segment in response to the user input and to control playback commands of the video data management system (selecting a program disclosed in col. 4, lines 7-19 and lines 46-58 and in col. 5, lines 10-30, 34-61);

recognizes connection of the external hard disk drive to the video recording system and subsequently identifies the external VTR as available for video data storage (detecting the connection with the VTR 22 disclosed in col. 5, lines 39-47 and col. 7, lines 19-26);

uses the external video data for the video program segment to provide video data (selecting television program disclosed in col. 4, lines 7-19 and in col. 5, lines 34-61); and

selects at least a portion of the video data to be routed to the external hard disk drive on the user input, an electronic program guide, and information regarding the storage capacity of the external hard disk drive (recording video data disclosed in col. 5, lines 31-61);

routes the selected portion of the video data to be routed to the external hard disk drive via the isochronous interface in order to record the external video data for the video program segment (recording video data disclosed in col. 5, lines 31-61). Sato et al also further teaches that video signal can be digital transmitted such as satellite digital broadcasting system (col. 1, lines 13-21) but fails to teaches that the medium is a hard disc drive as a storage means for storing the video information .

Goldwasser et al teaches a video recorder having a hard disc drive for storing the video stream wherein the playback commands are useable means that using an be used to record and playback video material independently, for example, as to allow the viewer to pause the playback for a variable period of time without interrupting the recording (col. 1, lines 55-60, column 2, lines 1-29) .

It would have been obvious to one of ordinary skill in the art at the time of the invention to using a hard disc drive having capability of recording and playing back video material independently as taught by Goldwasser et al as an alternative to the tape of Sato apparatus for storing the video information of Sato in order to provide more convenience to the user when using play back command for accessing the stored video information during recording the video information .

Regarding claim 26, Sato et al's Fig. 2 does not specifically disclose a personal video recorder that receives the external video data stream. However Sato et al teaches in col. 6, lines 61-65 that "in addition, in the configuration shown in FIG.2, one unit of TV is connected to one unit of VTR. It should be noted, however, that three or more AV

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apparatuses can be connected to each other in a configuration like the one shown in Fig. 1". Therefore, It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate additional AV apparatus such as VTR as taught in col. 6, lines 61-65 of Sato et al into Fig. 2 of Sato et al since it merely amounts to selecting additional AV apparatus because Sato et al teaches additional AV apparatus can be added to the system.

Regarding claim 27, Sato et al also teaches the claimed wherein the personal video recorder comprises an internal rotating storage drive (video disk disclosed in col. 7, lines 19-26).

Regarding claim 29, Sato et al discloses the claimed wherein the video data management system automatically recognizes connection of the external rotating storage drive to the video recording system (detecting the connection with the VTR 22 disclosed in col. 5, lines 39-47 and col. 7, lines 19-26).

Regarding claim 30, Sato et al discloses the claimed wherein the interface comprises an isochronous interface which is compatible with the IEEE 1394 standard (col. 6, lines 57-60).

Regarding claim 31, Sato et al discloses the claimed wherein the external video data stream and streaming video data include video data and audio data (col. 2, lines 56-65).

Method claim 35 is rejected for the same reasons as discussed in the corresponding apparatus claim 22 above.

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3. Claims 23-24, 32-33, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Goldwasser et al (US 5,241,428) as applied to claims 22 and 35 above, and further in view of Hedricks et al (US 5,990,927).

Regarding claim 23, the proposed combination of Sato et al and Goldwasser et al discloses all the claimed limitations as discussed in claim 22 above except for providing a set-top box that receives the external video data stream from a multiple-service operator.

Hedricks et al teaches a set top box (col. 3, lines 26-35) having user friendly interface for subscribers to access television programs (col. 2, lines 4859). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the set top box as taught by Hedricks et al into Sato et al's system in order to facilitate the capability of access to hundreds of television programming options.

Regarding claim 24, Hedricks et al also teaches that the set-top box comprises an internal hard disk drive (col. 15, lines 23-33).

Regarding claim 32, Hedricks et al teaches the claimed wherein the video data management system further comprises a video data encoder that encodes at least a portion of the streaming video data (col. 10, lines 26-29).

Regarding claim 33, Hedricks et al further teaches a video data encrypter (col. 9, lines 29-30) that encrypts video data to prevent unauthorized user accessing the video signal.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the video data encrypter as taught in Hendricks et al into Sato et al's system in order to prevent unauthorized user accessing the video signal.

Method claim 36 is rejected for the same reasons as discussed in the corresponding apparatus claim 32 above.

Method claim 37 is rejected for the same reasons as discussed in the corresponding apparatus claim 33 above.

4. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Goldwasser et al (US 5,241,428) as applied to claim 27 above, and further in view of Carroll et al (US 6,016,507).

The proposed combination of Sato et al and Goldwasser et al discloses all the claimed limitations as discussed in claim 6 above except for providing wherein the internal rotating storage drive is an internal hard disk drive comprising an IDE interface.

Carroll et al teaches a well known IDE hard disk 82 (col. 4, lines 23-37). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known IDE hard disk as taught by Carroll et al into Sato et al's system in order to increase storage capacity.

5. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Goldwasser et al (US 5,241,428) and Hendricks et al (US

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5,990,927) as applied to claim 24 above, and further in view of Carroll et al (US 6,016,507).

The combination of Sato et al, Goldwasser et al, and Hendricks et al discloses all the claimed limitations as discussed in claim 24 above except for providing wherein the internal hard disk drive is comprises an IDE interface. Carroll et al teaches a well known IDE hard disk 82 (col. 4, lines 23-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known IDE hard disk as taught by Carroll et al into Sato et al's system in order to increase storage capacity.

6. Claims 34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Goldwasser-et al (US 5,241,428) as applied to claims 22 and 35 above, and further in view of Sugiyama et al (US 5,815,631).

Regarding claim 34, the proposed combination of Sato et al and Goldwasser et al discloses all the claimed limitations as discussed in claim 22 above except for providing that the video data management system comprises an internal hard disk drive and routes at least a portion of the streaming video data to the internal disk drive.

Sugiyama et al teaches in the AV system, one AV device may be designated as an AV center and one or more AV devices may be coupled thereto and, as such, designated as a child (salve) AV device or devices (col. 4, lines 5360).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of selecting any AV device as AV center as taught in

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Sugiyama et al into Sato et al's system in order to increase the flexibility of the system of Sato et al. When the disk player is selected as AV center, the disk became internal rotating storage drive.

Method claim 18 is rejected for the same reasons as discussed in apparatus claim 34 above.

7. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (US 5,991,832) in view of Goldwasser et al (US 5,241,428) and Sugiyama et al (US 5,815,631) as applied to claim 38 above, and further in view of Wieland (DE 3106125 A1).

The proposed combination of Sato et al, Goldwasser et al, and Sugiyama et al discloses all the claimed limitations as discussed in claim 38 above except for providing that the method further comprises routing the portion of the streaming video data to the external hard disk drive when the storage capacity of the internal hard disk drive is insufficient to accommodate the anticipated size of the portion of the streaming video data to be recorded.

Wieland teaches that several video tape recorders are connected in parallel to the same TV receiver and switched on sequentially as their tapes run out (the abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of sequentially changing recording

media when recording space run out as taught by Wieland into Sato et al's system in order to complete record the video program even when recording space run out.

Response to Arguments

8. Applicant's arguments filed 03 July 2006 have been fully considered but they are not persuasive.

In Remark applicant argues that Sato does not teach using playback command in EPG . In response, the examiner disagrees . It is noted that at column 4, lines 45-60, column 5, lines 11-33, Sato teaches using EPG for playback command since Sato teaches using EPG information displayed on a screen for selecting recorded contents for playing back. The combination of Sato and Goldwasser further teaches playback command is usable during recording the information since Goldwasser teaches that playback command are usable during recording information. Applicant argues that Sato does not teaches playback command in EPG are usable during the recording. In response, it is noted applicant argument does not reflect the claims since the claims do not specify that the playback command in EPG are usable during recording .

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N


HUYNH NGUYEN
PRIMARY EXAMINER